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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 747,589	12 22 2000	Leon G. Street	P04774US0 PH1 1345	8234

273.00 7590 07 29 2002

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EXAMINER

MEHTA, ASHWIN D

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 07 29 2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/747,589

Applicant(s)

STREIT ET AL.

Examiner

Ashwin Mehta

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other

**DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. The objection of claims 13, 14, 35, and 36 is withdrawn, in light of the claim amendments.
3. The rejection of claims 5 and 27, and claims dependent thereon, under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, in the Office action mailed 18 December 2002, on page 4, 1<sup>st</sup> full paragraph, is withdrawn, upon further consideration.
4. The rejection of claims 9, 20, 31, and 39, and claims dependent thereon, under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, in the Office action mailed 18 December 2002, on page 4, 2<sup>nd</sup> full paragraph, is withdrawn, in light of the claim amendments.
5. The rejection of claims 10, 21, 22, 27, 32, 40, 44, and 49, and claims dependent thereon, under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, in the Office action mailed 18 December 2002, on page 4, last full paragraph, is withdrawn, upon further consideration.

Art Unit: 1638

6. The rejection of claims 13 and 14 under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, in the Office action mailed 18 December 2002, on page 5, 1<sup>st</sup> full paragraph, is withdrawn, in light of the claim amendments.

7. The rejection of claims 23 and 45 under 35 U. S.C. 112, 2<sup>nd</sup> paragraph, in the Office action mailed 18 December 2002, on page 5, 3<sup>rd</sup> full paragraph, is withdrawn, and replaced with the indefinite rejection below.

#### ***Claim Objections***

8. Claims 1, 7, 29, and 46 remain objected to, for the reasons of record stated in the Office action mailed 18 December 2001 under item 1. Applicants traverse the objection in the paper received 20 May 2002. Applicants indicate that the ATCC deposit number will be inserted into the claims once notice of allowable claims has been received (response, page 3, 2<sup>nd</sup> full paragraph). Applicants' intent is acknowledged. As the claims are not in condition for allowance, the objection is maintained.

#### ***Double Patenting***

9. Claims 10, 12, 15-17, 18 (amended), 19, 20 (amended), 21, 22, 32, 34, 37, 38, 39 (amended), 40-42, 43 (amended), 44, and 47-49 remain rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 6,153,816, for the reasons of record stated in the Office action mailed 22 December

Art Unit: 1638

2001 under item 3. Applicants traverse the rejection in the paper received 20 May 2002.

Applicants' arguments have been fully considered but were not found fully persuasive.

Applicants argue that the inventions 92B84 and 93B35 differ for various traits that are not minor, and cite several of these traits (response, page 4, first six paragraphs). This argument was found persuasive for claims 1-9, 11, 13, 14, 24-31, 33, 35, 36, and 46. However, the remaining claims still broadly encompass the subject matter of the patented claims.

***Claim Rejections - 35 USC § 112***

10. Claims 1-8, 9 (amended), 10-12, 13-14 (both amended), 15-17, 18 (amended), 19, 20 (amended), 21-30, 31 (amended), 32-34, 35-36 (both amended), 37, 38, 39 (amended), 40-42, 43 (amended), and 44-49 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants traverse the rejection in the paper received 20 May 2002. Applicants' arguments were fully considered but were not found persuasive for all of the issues.

Applicants argue, regarding the issue of the "92B84" designation, that the claims will be amended to recite the ATCC deposit number when a notice of allowable claims has been issued (response, paragraph bridging pages 4-5). Applicants' intent is acknowledged. The rejection is maintained, as the claims are not in condition for allowance.

Regarding the rejection of claims 18 and 43, for improper antecedent basis and the recitation "An F1 hybrid soybean seed plant": Applicants have removed the word "seed" from

Art Unit: 1638

the recitation (response, page 6, 3<sup>rd</sup> full paragraph). However, the claims still lack proper antecedent basis. Claims 17 and 42 are drawn to soybean plants, not seeds.

Regarding the rejection of claim 35, for improper antecedent basis: Applicants argue that the claim amendments to refer to a "method" and to remove the term "inbred" obviate the rejection (response, page 6, 5<sup>th</sup> full paragraph). However, the claim still lacks proper antecedent basis for the recitation "The method of claim 31 for producing a first generation hybrid soybean seed". The method of claim 31 is dependent on the method of claim 30, which is for developing a soybean plant in a soybean plant breeding program.

Regarding the rejection of claim 48, for the recitations "growing said progeny soybean seed of step (a), and for the reference of steps (a) and (b) in step (c): Applicants argue that this is common claim construction and submit that this is not indefinite (response, paragraph bridging pages 6-7). However, as written, the method of claim 48 comprises two steps designated (a) and (b). To clearly distinguish the steps, it is suggested that steps (a)-(c) of claim 48 be changed to steps (c)-(e), respectively.

11. Claims 23 and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terms "relative", "very good", "moderate," "above average," "substantial degree," and "particularly suited" are relative terms that have no definite meaning. The terms do not reasonably apprise one of the scope of the invention. It is not clear what type of yield (i.e. grain yield, pollen yield, seed yield, etc.) is referred to by the recitation "very good yield". The

Art Unit: 1638

recitation "North Plains, Plains, Southern Plains and Eastern regions of the United States including" also renders the claims indefinite. It is not exactly clear what states or geographic areas, besides those stated in the claim, make up these regions.

12. Claims 10, 21-23, 32, 40, 44, 45, and 49 remain and claims 12, 15-17, 18 (amended), 19, 20 (amended), 34, 37, 38, 39 (amended), 41, 42, 43 (amended), 47, and 48 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for the reasons of record stated in the Office action mailed 18 December 2001 under item 5 for claims 5, 6, 10, 21-23, 27, 28, 32, 40, 44, 45, and 49. Applicants traverse the rejection in the paper received 20 May 2002. Applicants' arguments have been fully considered, but were not found fully persuasive. The rejection has been withdrawn from claims 5, 6, 27, and 28, after further consideration.

Applicants argue that there is a great detail in the specification as to culture techniques and breeding techniques and how one applies these techniques to soybean plant 92B84 to generate the derived plants, and that claims 23 and 45 even indicate that the plant must possess at least two of several enumerated traits that must be from plant 92B84. Applicants argue that each plant that is created using Applicants' unique and novel material must possess the unique germplasm that forms the invention (response, page 7, 1<sup>st</sup> full paragraph). However, methods of making the claimed plants do not describe the plants themselves. The claims encompass plants that can have any trait, and encompass plants that do not share any trait in common with 92B84.

Art Unit: 1638

Further, many plants share numerous traits in common with 92B84. If one of these plants is also an ancestor of one of the claimed plants, then a common trait expressed by that descendent might not be due to germplasm inherited from 92B84. The specification does not provide any information regarding why any particular trait of 92B84 is unique only to that plant. Applicants argue that descendants of 92B84 will possess its germplasm. However, the specification does not describe the aspects of the germplasm that distinguish it as being unique only to 92B84, or to any particular trait of 92B84. The description of soybean plant 92B84 is not indicative of any of its descendants. The transgenes introduced into the claimed plants may be of gene(s) that effect any trait or more than one trait. Such plants would express different morphological and physiological traits from 34B97, and which are not described.

13. Claims 1-8, 9 (amended), 10-12, 13-14 (both amended), 15-17, 18 (amended), 19, 20 (amended), 21-30, 31 (amended), 32-34, 35-36 (both amended), 37, 38, 39 (amended), 40-42, 43 (amended), and 44-49 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, for the reasons of record stated in the Office action mailed 18 December 2001 under item 6. Applicants traverse the rejection in the paper received 20 May 2002. Applicants' arguments were fully considered but were not found persuasive.

Applicants indicate that the deposit of the seed with the ATCC will be made upon receipt of a notice of allowability, and that the claims will be amended to include the accession number at that time (response, page 8, 1<sup>st</sup> full paragraph). Applicants' intent is acknowledged.



Art Unit: 1638

***Claim Rejections - 35 USC § 102 & 103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 10, 12, 15-17, 18 (amended), 19, 20 (amended), 21-23, 32, 34, 37, 38, 39 (amended), 40-42, 43 (amended), 44, 45, and 47-49 remain rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Steiger et al. (U.S. Patent No. 6,153,816), for the reasons of record stated in the Office action mailed 18 December 2001 under item 7, for claims 1-49. Applicants traverse the rejection in the paper received 20 May 2002. Applicants' arguments were fully considered but were not fully found persuasive.

Applicants argue that 93B35 and 92B84 differ in several traits, such as flower color, and susceptibility to sudden death syndrome (response, page 4, first 5 paragraphs and page 8, 3<sup>rd</sup> full

Art Unit: 1638

paragraph). This argument was found persuasive for claims 1-9, 11, 13, 14, 24-31, 33, 35, 36, and 46.

Applicants again argue that the claimed plant cannot be rendered obvious or lacking novelty as it possesses a unique combination of traits which confers a unique combination of genetics, and that the differences between 92B84 and 93B35 are not minor (response, page 8, 2<sup>nd</sup> and 3<sup>rd</sup> full paragraphs). However, as discussed above the claims do not distinguish the claimed plants from those taught by Steiger et al.

Applicants also argue that though 93B35 and 92B84 exhibit some similar traits, what is being claimed is not the trait but the unique combination of alleles contained in 92B84, and that it is this unique combination of genetics and traits in 92B84 that will give rise to the claimed plants resulting from with this breeding material. Applicants also argue that 92B84-derived plants are themselves unusual and a nonobvious result of a combination of previously unknown and nonobvious genetics (response, page 9, 1<sup>st</sup> and 2<sup>nd</sup> full paragraphs). However, the claims do not make any mention of any alleles of 92B84. Further, as evidenced by 93B35, many plants possess at least two of the enumerated traits that are also expressed by 92B84. The claims do not define any of the "unique combination of genetics" that give rise to the traits of 92B84, but indicate that the claimed plant expresses at least two of the listed traits, or can have any traits. In the absence of a way of identifying any part of the claimed plant as having come from 92B84, any plant expressing at least two of the listed traits will anticipate or render obvious the claimed invention. The specification does not teach how the combination of genetics or germplasm of 92B84, or its descendents, are distinguished from other soybean plants. The specification does not teach, for example, how the combination of genetics that gave rise to the resistance to Brown

Art Unit: 1638

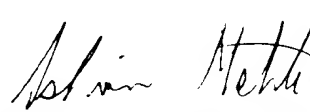
Stem Rot expressed by 92B84 is different from the combination of genetics that gave rise to that trait in 93B35. See In re Thorpe, 227 USPQ 964,966 (Fed. Cir. 1985), which teaches that a product-by-process claim may be properly rejectable over prior art teaching the same product produced by a different process, if the process of making the product fails to distinguish the two products.

15. No claim is allowed.

#### ***Contact Information***

Any inquiry concerning this earlier communications from the examiner should be directed to Ashwin Mehta, whose telephone number is 703-306-4540. The examiner can normally be reached on Mondays-Thursdays and alternate Fridays from 8:00 A.M to 5:30 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached at 703-306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 and 703-872-9306 for regular communications and 703-872-9307 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

July 24, 2002

  
**ASHWIN D. MEHTA, PH.D**  
**PATENT EXAMINER**